

## REMARKS

Claims 1 – 20 remain in the application and stand rejected. Claims 1, 3 – 9 and 11 – 18 are amended herein. No new matter has been added.

Claims 1 – 20 are rejected under 35 USC 112 as failing to comply with the written description requirement. Specifically, claims 1 and 9 are rejected for reciting inserting visual cues and/or unseen markers into the documents. Partially responsive thereto, claims 1 and 9 are amended herein to recite “inserting visual feedback into the original document, said visual feedback being responsive to interactions with said displayed document and being indicated by changes to displayed visual cue objects, interactions with said displayed document creating an amended document file;” as recited in claim 1, for example, at lines 10 – 13. This is supported in the application. For example,

[w]hen executing with a document viewing application program as described above, the plug-ins of the present invention **insert visual feedback** directly into the source document (for example, adding a dog-ear corner to the upper right page corner to show duplex printing, see FIG. 2), so any **user interactions in the source document apply to the visual feedback as well**. For example, as the user **moves pages** around in the document, the visual feedback moves with the page automatically. When the visual cues are added to the document, the plug-ins keep track of the objects to which they have added themselves and which were in the document originally.

Paragraph 0015 (emphasis added). With regard to the rejection of claim 2 and 10, claims 1 and 9 are further amended to recite that “any changes to said print job ticketing parameters made by said interactions [are] included in a print job ticket for the amended document.” which is supported by paragraphs 0017 – 30, for example. With regard to the rejection of claim 5 and 13, claims 1 and 9 are further amended to recite inserting “into the original document display a plurality of visual cue objects” which is supported by the specification which recites, for example, “using a standard document viewing application, such as Adobe Acrobat Exchange, Microsoft Word or others, to **display the**

**document and the visual feedback cues** associated with the currently selected print job parameters.” paragraph 0006 (emphasis added). No new matter is added. Thus, claims 1, 2, 5, 9, 10 and 13 are believed to comply with the written description requirement.

Claims 3 and 11 are rejected for reciting that the specific operation is “initiating an immediate print operation.” Responsive thereto, claims 3 and 11 are amend to recite that the specific operation is “initiating a print, said print job ticket being created responsive to initiating.” This is supported by the specification, e.g., at paragraphs 0015, 20 and 28. No new matter is added. Thus, claims 3 and 11 are believed to comply with the written description requirement.

With regard to claims 4 and 12, the specification provides that “[p]referably, the plug-ins add a hidden or unseen marker to the visual cue objects, but alternatively the plug-ins could keep a list of visual cue object IDs.” Clearly this describes adding markers *to the document that are linked* to the visual cue objects. Adding the markers to the visual cue objects, for example, makes no sense. Thus, claims 4 and 12 are believed to comply with the written description requirement. Accordingly, for the amendment to the claims and for the reasons set forth hereinabove, claims 1 – 20 are believed to comply with the written description requirement. Reconsideration and withdrawal of the rejection of claims 1 – 20 under 35 USC §112 is respectfully requested.

Claims 1 – 5 and 9 – 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,614,454 to Livingston in combination with U.S. Patent No. 5,999,945 to Lahey et al. Claims 6 – 8 and 14 – 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Livingston and Lahey et al. in view of published U.S. Patent Application No. 2002/0184305 to Simpson et al. Claims 17 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Livingston and Lahey et al. in view of U.S. Patent No. 6,268,924 to Koppolu et al. Claims 18 and 20 are rejected

under 35 U.S.C. §103(a) as being unpatentable over Livingston, Lahey et al. and Simpson et al. in view of Koppolu et al.

Livingston teaches a “printer control system [that] includes memory ... [with a] document to be printed, a print engine ... to print a document ... and a display configured to provide an image of a graphical user interface in a viewing window.” *See, e.g.*, Livingston, Figure 3A and col. 2, lines 12 – 18. As previously noted, the GUI in the Livingston printer control system “is configured to allow user selection and modification of print engine options for printing the document.” *Id.* lines 19 – 22. More specifically, one can use the Livingston printer control system GUI to configure the system printer, selecting print engine options to configure/control the printer. Thus, Livingston operates on the printer, not the document being printed.

Livingston fails to even mention job tickets, much less modifying or creating a job ticket in the Livingston printer control system for the Livingston printer. Neither does Livingston teach or suggest interactions with the Livingston printer control system GUI otherwise modifying the document, e.g., rearranging pages, much less editing. Further, the Livingston printer control system GUI is not invoked by viewing the document, i.e., “opening a document viewing application,” the “print preview image” is viewed because the Livingston printer control system GUI is active.

Lahey et al., relied on to teach printing an amended document responsive to a print job ticket, teaches “organizing the component files and the job tickets in a common directory.” Col. 1, lines 62 – 64. Further, Lahey et al. teaches a GUI that operates solely on print tickets. Figures 2 – 10 and 12, col. 7, line 46 – col. 12, line 19. “FIG. 12 is a flowchart that illustrates more specific logic performed by the InfoPrint Submit software 10 when the GUIJ [sic] 60 is displayed as indicated at 114.” Lahey et al. describes creating job tickets on client systems 4a, b, c, and submitting those jobs to a server 6. Col. 7, lines 15 – 25. The Lahey et al. server 6 corresponds to the Livingston printer

control system. “The user [on client systems 4a, b or c] creates the job ticket 40 by entering information into different fields and selecting specific options presented in the GUI 60.” *Id.*, lines 50 – 53.

Neither does Lahey et al. teach or suggest interactions with the Lahey et al. GUI otherwise modifying the document, e.g., rearranging pages or less editing. Nor does Lahey et al. invoke the GUI from, and in, a document viewing application. Therefore, the combination of Livingston and Lahey et al. fails to result in the present invention as recited in the claims 1 and 9, as amended, and all claims depending therefrom. Reconsideration and withdrawal of the rejection of claims 1 – 5 and 9 – 13 under 35 USC §103(a) is respectfully requested.

With regard to claims 6 – 8 and 14 – 16, the Office Action relies on Simpson et al. to teach a “plug in to a document editor providing a plug in interface (page 1, paragraph 3).”

First, applicants note that Simpson et al. describes using an Adobe Acrobat *web browser* plug-in to preview web page print output. Simpson et al. page 1, paragraph 3, lines 1 – 9. Moreover, Simpson et al. indicates that the resulting preview may be inaccurate. *Id.*, lines 9 – 17. Therefore, Simpson et al. indicates that using an Adobe Acrobat *web browser* plug-in to preview web pages in combination with Livingston and Lahey et al. provides inadequate and, possibly undesirable, results. Such a combination of Livingston and Lahey et al. with Simpson et al. is, therefore, not an obvious combination.

Furthermore, Simpson et al. neither teaches nor suggests using the web browser (the Simpson et al. document viewing application) in response to user interactions to otherwise modify the web pages. One does not edit with a web browser. Therefore, the combination of Livingston, Lahey et al. and Simpson et al. fails to teach, suggest or result

in the present invention as recited in the claims 6 and 14, as amended, and is not an obvious combination. Reconsideration and withdrawal of the rejection of claims 6 – 8 and 14 – 16 under 35 USC §103(a) is respectfully requested.

With regard to claims 17 – 20, the Office Action relies on Koppolu et al. to teach thumbnail print previews. While Koppolu et al. teaches “displaying the plurality of visual cue objects in thumbnails” (col. 6, lines 36 – 37), Koppolu et al. does not provide anything to teach or suggest what is missing from Livingston and Lahey et al., alone or further in combination with Simpson et al., to result in the present invention as recited in claims 1 or 9, much less claims 17 – 20 depending therefrom. Accordingly, since dependent claims include all of the differences with the references as the claims from which they depend, Koppolu et al. in combination with Livingston and Lahey et al., alone or further in *non*-obvious combination with Simpson et al. does not teach, suggest or result in the present invention, as recited in claims 17 – 20. Reconsideration and withdrawal of the rejection of claims 17 – 20 under 35 U.S.C. §103(a) over Koppolu et al. in combination with Livingston and Lahey et al., alone, or further in *non*-obvious combination with Simpson et al., is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 – 20 under 35 U.S.C. §§112 and 103(a) and allowance of the application to issue.

Should anything further be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

AMENDMENT  
June 14, 2010

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Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

June 14, 2010  
(Date)

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